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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/980,366 | 11/28/2001 | Akio Ishii | KIUI-BQ23 | 1338 |

21611 7590 11/20/2003

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EXAMINER

MARCANTONI, PAUL D

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| ART UNIT | PAPER NUMBER |
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1755

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ab 15

Office Action Summary

Application No.
09188 980,366

Applicant(s)
Ishii et al.

Examiner
Paul Marcontani

Group Art Unit
1755

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/3/03 (RCE filing)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 2, 4, 5, + 7-14 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1, 2, 4, + 5 is/are allowed.
- ☒ Claim(s) 7, 8, 10, 11, 13, + 14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Applicant's arguments filed 11/3/03 have been fully considered but they are not persuasive.

Rejection over Prior art withdrawn:

Watanabe et al. '030 has been withdrawn as a prior art rejection.

35 USC 112 Second Paragraph:

Claims 7, 8, 10, 11, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms "predetermined" added by amendment are indefinite terms. Removal of these terms is advised in claims 7 and 8.

Claim 10 contains new matter as well. The terms "wherein the particle size of the refractory metal oxide being sized in the range of 2 microns to 3 microns constitute new matter. There is no support for any other refractory metal oxides (zircon, magnesia, mullite, spinel, silica) except for alumina having a particle diameter of 2 to 3 microns (See embodiment 3, page 23 of applicants' specification). This can be resolved by amending the claim to indicate that the refractory oxide is alumina in claim 10.

In claim 11, the range of "approximately 1 micron to 74 microns" is also new matter because the original disclosure on page 23 only supports "74 microns or less" and there is no support for the word "approximately" nor 1 micron. This range thus represents new matter. Applicants neglected to address this in their response.

Also, on page 23 of the applicants' specification, the term "silicone" should be – silicon—and amendment is advised ("silicone is 74 microns or less).

Claims 13-14 are new matter because there is no support for "greater than 6 to 15% by mass". There is only support for the range of 5 to 15% by mass.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Paul Marcantoni
Primary Examiner
Art Unit 1755